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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,565	07/21/2000	Miri Seiberg	JBP0510	4999

7590 05/25/2004  
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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
1615	

1615

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

<b>Application No.</b> 09/621,565	<b>Applicant(s)</b> SEIBERG ET AL.	
<b>Examiner</b> Blessing M. Fubara	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 17 February 2004.
- 2a)  This action is FINAL.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-22 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/05/04.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Examiner acknowledges receipt of request for extension of time and amendment filed 02/17/04 and IDS filed 03/05/04.

#### **Claims**

Claims 23-52 were cancelled on 06 February 2003 in an interview with applicants' attorney. These claims cannot be reintroduced in the application as original withdrawn claims. The cancelled claims may be introduced numbered starting with claim no 53. However, it may be noted that those claims if submitted will be subject to the restriction/election requirement that led to their withdrawal. Therefore, claims 1-22 continue to be examined.

#### ***Claim Rejections - 35 USC § 112***

1. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the amendment to claim 1.

#### ***Claim Rejections - 35 USC § 102***

2. Claims 1-3, 6, 7, 9, 16 and 19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Costanzo (US 6,323,219).

Applicants argue that Costanzo does not suggest or describe methods where applicants' composition is used to affect hair and that although Costanzo mentions changes in skin pigmentation due to the application of certain composition to the skin, Costanzo does not state that such a composition has any effect on hair growth.

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3. Applicants' arguments filed 02/17/04 have been fully considered but they are not persuasive.

The instant method involves topical application to the skin a topically active composition that comprises one or more compounds derived from one or more of the botanical families. Since the instant method topically applies a composition and Costanzo topically applies to the skin a composition that reads of the instant composition, it would be inherent that the composition of the prior art affects the skin the same way as the instant composition affects the skin. The effect of the composition is inherent. Thus, although Costanzo does not specifically disclose that the composition has an effect on hair growth, since the instant claim and Costanzo apply the same composition to the skin, the effect on the skin from both compositions would be the same. Secondly, the composition having an effect on hair growth is not a limitation of instant claim 1 and limitations from the specification cannot be read into a claim. The rejection is reiterated below.

Costanzo discloses topically applying pharmaceutical or cosmetic composition in an amount effective to mammalian skin to effect changes in pigmentation (column 10, lines 13-17) and soybean milk or other formulations derived directly from legumes is applied to the mammalian skin (column 9, lines 47-52). Costanzo discloses that extracts from the plant families of leguminosae, solanaceae, gramineae and cucurbitacea contain serine protease inhibitors (column 8, lines 52-57). The teaching of Costanzo meets the limitations of the claims.

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*Claim Rejections - 35 USC § 103*

4. Claims 4, 5, 8, 10-14, 16-18 and 20-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Costanzo (US 6,323,219) in view of JP 9059166 A.

Applicants argue that Costanzo does not suggest changes in hair appearance and that although Costanzo applies composition that contains soy, the JP 9059166 reference that discloses the presence of isoflavones in soy teaches away from the methods and compositions of the instant claims

5. Applicants' arguments filed 02/17/04 have been fully considered but they are not persuasive.

As discussed above, Costanzo discloses the instant method and the JP reference is relied upon a teaching that soy contain isoflavones. The rejection is reiterated below.

The teachings of Costanzo is discussed above and Costanzo discloses the method of the instant claims. Regarding claims 4 and 5, there is no showing demonstrating that the amount of the inhibitor provides unusual results. Regarding claims 11-14, 16-18 and 20-22, since the composition of the prior art is applied to the skin, the composition would exhibit the properties of the composition on the skin.

Costanzo does not teach that the composition comprising the plant extracts contains isoflavones. However, JP 9059166 discloses that soybean extract contains isoflavones (English abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the extract of soy bean to apply to the skin in order to effect changes in mammalian hair appearance. One having ordinary skill in the art would have been

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motivated to include isoflavone in the composition of Costanzo with the expectation that the composition produce changes in the mammalian hair appearance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 242-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara  
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